

|                              |                                      |                                       |  |
|------------------------------|--------------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/943,799 | <b>Applicant(s)</b><br>GLASGOW, JINAN |  |
|                              | <b>Examiner</b><br>ANH LY            | <b>Art Unit</b><br>2162               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>04/30/10@10:07AM</u> .                   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application  |
| Paper No(s)/Mail Date _____.  | 6) <input type="checkbox"/> Other: _____.                          |



### **DETAILED ACTION**

1. This Office Action is response to Applicant, AMENDMENT filed on 04/19/2010.
2. Claims 6 and 18-19 were cancelled.
3. Claims 1-5 and 7-17 are pending in this Application.

### ***Response to Arguments***

4. Applicant's arguments filed 04/19/2010 have been fully considered but they are not persuasive.

5. Applicant argued that, "the Examiner has not established a prima facie case of obviousness with respect to claims 1-5 and 7-17." (page 9, 20-21), in the Remarks).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Tran (2006/0190807 A1), Rivette et al. (Pub. No.: US 2007/0208669 A1, hereinafter as Rivette) and Blair et al. (Pub. No.: US 2002/0112114 A1, hereinafter as Blair) are from the same field of endeavor and they are directed to graphical user

Art Unit: 2162

interface for display or viewing or visualizing the tree or hierarchical tree of documents.

One having ordinary skill in the art would have found it motivated to combine the teachings of Tran, Rivette and Blair because that would provide Tran's system the enhanced capability of providing a single window can be used to view all components of a document or documents. Moreover, the examiner kindly submits that the applicants misread the applicable references used in the last office action. However, when read and analyzed in light of the specification, the invention as claimed does not support applicant's assertions. Actually, applicants are interpreting the claims very narrow without considering the broad teaching of the references used in the rejections.

Additionally, it is important to note that the examiner interpretation of the claims, wherein, the examiner explicitly stated passages in the cited references which were not even addressed. The aforementioned assertion wherein all the limitations are not taught or suggested by the prior of record, was unsupported by objective factual evidence and was not found to be substantial evidentiary value. The examiner has provided in the last office action, a convincing one of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the cited references.

Applicants are reminded that 37 CFR 1.111(b) states, a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Therefore, the applicants have failed to provide prima facie evidence how the language of the claims patentably distinguished them from the cited references. Hence, the applicants' assertions are just mere allegation with no

Art Unit: 2162

supported fact. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant argued that, "Tran and Rivette nowhere teach, disclose or suggest the automatically generated hierarchical diagram including at least one key component and at least one subcomponent associated ..., where the text based and graphical-based component are integrally visually ... in a single interactive diagram." (page 9, the last paragraph and page 10, lines 1-2, in the Remarks).

TRAN (Pub. No.: US 2006/0190807 A1) teaches methods and system for processing intellectual property assets; drafting or writing patent applications; creating and displaying a claim tree under graphical interface, diagramming elements of the claim in a graphical representation: a flowchart of steps of claim drafting with user input and including the system diagramming the elements of a claim via a computer system via a Internet/communication network as shown in fig. 1, para 0035 and 0038). The window displays (fig. 3B) a hierarchical diagram claim tree: the independent claims are key components; the dependent claims are sub-components and the claim languages of

Art Unit: 2162

each key component and subcomponent in parallel with claim tree (fig. 3A, para 0052 and including at the step 312, the system diagramming the elements of a claim, para 0068-0079 and fig. 3B, graphical user interface for a claim tree with its component textual or component content; illustrating the diagrammed claim, showing the hierarchy of elements para 0080; wherein the highest level node in fig. 3B is the claimed at least one key component. While RIVETTE (Pub. No.: US 2007/0208669 A1) teaches the graphical component of a patent including drawings, claims, abstract, summary and detail specification and is illustrated and displayed under a hierarchical tree with graphical component structure (para 0429 and 0980 and fig. 73 and 164; claim tree: fig. 185; para 1368-1369). And BLAIR (2002/0112114 A1) teaches a navigation tree and text document with links shown as in the fig. 2, the tree navigation structure. All the structure or directory of document and the text- based document are integrally in a same window with modifiable graphical hierarchical tree structure (para 0030-0032; also, see para 0014-0016).

For the above reasons, Examiner believed that rejection of the last Office action was proper.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2162

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and 7-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over TRAN (Pub. No.: US 2006/0190807 A1; Continuation of application No.

09/792,828, filed on FEB. 24, 2000) in view of Rivette et al. (Pub. No.: US 2007/0208669 A1, Continuation of application No. 11/178,367, filed on JUL. 12th, 2005, which is a Continuation of application No. 09/545,608, filed on APR. 7th, 2000, hereinafter as RIVETTE) and further in view of Blair et al. (Pub. No.: US 2002/0112114 A1, hereinafter as BLAIR).

With respect to claim 1, TRAN teaches a system for drafting a patent application and assessing technological information on at least one computer (fig. 1, a system for user(s) such as IP specialist or attorney in drafting or writing patent applications or patent claims as well as technical information as legal matters for a patent application: para 0006, 0010 and 0132-0133), the system comprising:

at least one input device connected to the at least one computer for inputting information from at least one user, wherein the inputs include a text-based description of an invention (inputting from one of client computers: fig. 1, items 104 and 106, para 0035; drafting or writing patent application, which is a text-based description of an invention: para 0006, 0010 and 0132-0133);

at least one processing means for generating a diagrammatic representation of the invention by automatically (using graphical user interface and software for assisting the user in generating a patent application: para 0042-0043 and fig. 2A and 2C,

Art Unit: 2162

processing the application via computer system as automated processing), wherein the diagrammatic representation includes a hierarchical component categorization of the technical components including at least one key component and at least one subcomponent associated with the at least one key component of the invention based upon the information inputted by the at least one user (fig. 3B a claim tree, para 0068 and para 0006, 0010 and 0132-0133), and for automatically generating a document for filing as a patent application (automatically generating a patent application: fig. 2's para 0042), including specification and claims, based upon the information inputted by the at least one user and additional text-based detailed information that is organized consistent with the diagram (technical component such as background, description, drawings and claims: abstract, figs. 2C, 3A and 4-5, para 0008, 0016, 0046 and 0101-0103); wherein the hierarchical component categorization includes at least one key component and at least one subcomponent related thereto, wherein the hierarchical component categorization contains the full text of the textual component content; wherein the diagrammatic representation of the components and subcomponents together provides an indication of what may be claimed in a patent application (independent claims and dependent claims: in fig. 3B claim tree and para 0053-0054);

at least one output device connected to the at least one computer for outputting the automatically generated diagrammatic representation of an invention (the claim tree is displayed on the desktop screen, output device: para 0127 and fig. 3B); and

wherein the diagram is modifiable by the at least one user and the diagram hierarchical component categorization and related text-based detailed information is



Art Unit: 2162

automatically updated based upon the user modifications (the text of a patent application is enabling to update or edit: para 0044 and claim tree is also able to move or to modify (drag/drop claims): para 0068).

TRAN teaches methods and system for processing intellectual property assets; drafting or writing patent applications; creating and displaying a claim tree under graphical interface, diagramming elements of the claim in a graphical representation: a flowchart of steps of claim drafting with user input and including the system diagramming the elements of a claim. The window displays icons and drop-down menus. By clicking on items in the background windows, a user can navigate the claim tree. The user such as IP specialist or attorney in drafting or writing patent applications or patent claims as well as technical information as legal matters for a patent application, generating an patent application including some technical components such background, invention summary, drawings, description, abstract and claims and displaying the claim tree to user. Also, TRAN teaches displaying a flowchart of steps of claim drafting with user input (fig. 3A, para 0052) and including at the step 312, the system diagramming the elements of a claim (para 0068-0079) and fig. 3B illustrating the diagrammed claim, showing the hierarchy of elements (para 0080), analogous to the claimed components and subcomponents, wherein the highest level node in fig. 3B is the claimed at least one key component. TRAN does not explicitly teach wherein the diagrammatic representation comprises graphical component structure and textual component content associated with each component such that for each component, the graphical component structure includes the textual component content and wherein the

Art Unit: 2162

text-based information and the diagram components are automatically directly linked by being visually integrated with one another within the graphical component structure as claimed.

However, RIVETTE teaches image file and text file are presentations of patent (para 0429); the patent is represented by icon (para 0980 and fig. 73 and 164); claim tree (fig. 185; para 1368-1369); hyperlinking using a linked list of nodes for switching to view the desired component (para 1231-1233; also para 1236-1240). This is the same as the graphical component of a patent including drawings, claims, abstract, summary and detail specification and is illustrated and displayed under a hierarchical tree with graphical component structure (see figs 164 and 185) and classification or categorization the patent/document (para 0727, 1434, and 2080).

Therefore, based on TRAN in view of RIVETTE, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of TRAN with the teachings of RIVETTE. One having ordinary skill in the art would have found it motivated to utilize the use of graphical representation of a source patent and claim as well (RIVETTE's para 1368-1368; fig. 164 and 185), into the system of TRAN for the purpose of having tools including modules to track and process of Patent or Intellectual property related transaction such as license agreements, therefore, enabling user to use automated tools that automatically process patent related information for making corporate business decision (RIVETTE's para 0003-0008 and 0020-0021). Combination of TRAN and RIVETTE do not teach wherein the

Art Unit: 2162

graphical component structure and textual component content being integrally visually generated and link in a single interactive diagram as claimed.

However, BLAIR teaches a navigation tree and text document with links shown as in the fig. 2, RFQ that is selected from the tree navigation structure. As shown in this example, this is a text document with PDF format that includes hyperlinks; the RFQ by showing a tree navigation arrangement on the left side of the screen, and corresponding details on the right side. As shown in this example, the navigation tree in the electronic RFQ basically operates as a Table of Contents (TOC) to the RFQ documents (para 0030-0032). All the structure or directory of document and the text-based document are integrally in a same window with modifiable graphical hierarchical tree structure.

Therefore, based on TRAN in view of RIVETTE, and further in view of BLAIR, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of BLAIR to the system of TRAN and RIVETTE. One having ordinary skill in the art would have found it motivated to utilize the use of interactive diagram as disclosed (BLAIR's para 0030-0032), into the system of TRAN for the purpose of providing documents in PDF format for easing to extract, thereby, enabling to provide a single application or document can be used to view all documents (BLAIR's figs. 1 and 2, para 0002-0004, 0014-0016 and 0030-0032).

With respect to claim 2, TRAN teaches wherein the diagram is modifiable by the at least one user and the diagram hierarchical component categorization and related text-based detailed information is automatically updated based upon the user

Art Unit: 2162

modifications (the text of a patent application is enabling to update or edit: para 0044 and claim tree is also able to move or to modify (drag/drop claims): para 0068).

With respect to claim 3, TRAN teaches wherein the at least one key component includes a multiplicity of components (such as one independent claim has one or more dependent claims as shown in the fig. 3B: claim tree: para 0068 or a patent application has background, summary, description, drawings and claims components: para 0008, 0016 and 0044-0045).

With respect to claim 4, TRAN teaches wherein the at least one subcomponent further includes at least one sub-subcomponent (independent and dependent claims: claim tree: para 0068 and 0053-0054).

With respect to claim 5, TRAN teaches wherein the relational connection between components establishes the claims structure of the patent application (relationship between component in the data structure: para 0101 and fig. 4).

With respect to claims 7-10, TRAN teaches a system for drafting a patent application as discussed in claim 1.

TRAN teaches methods and system for processing intellectual property assets; drafting or writing patent applications; creating and displaying a claim tree under graphical interface, diagramming elements of the claim in a graphical representation: a flowchart of steps of claim drafting with user input and including the system diagramming the elements of a claim. The window displays icons and drop-down menus. By clicking on items in the background windows, a user can navigate the claim tree. The user such as IP specialist or attorney in drafting or writing patent applications

Art Unit: 2162

or patent claims as well as technical information as legal matters for a patent application, generating an patent application including some technical components such background, invention summary, drawings, description, abstract and claims and displaying the claim tree to user. Also, TRAN teaches displaying a flowchart of steps of claim drafting with user input (fig. 3A, para 0052) and including at the step 312, the system diagramming the elements of a claim (para 0068-0079) and fig. 3B illustrating the diagrammed claim, showing the hierarchy of elements (para 0080), analogous to the claimed components and subcomponents, wherein the highest level node in fig. 3B is the claimed at least one key component. TRAN does not explicitly teach wherein the link(s) are hyperlinks; wherein the document and diagram are capable of being output into another software program; wherein the document and diagram axe exportable in HTML format; and wherein the document and diagram are exportable in XML format as claimed.

However, RIVETTE teaches hyperlinking using a linked list of nodes for switching to view the desired component (para 1231-1233; also para 1236-1240); software programs for outputting (para 0405, 0667 and 1705); and mark-up format or data such as HTML or XML (para 0605-0606, 0656, 0668 and 1250).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of RIVETTE. One having ordinary skill in the art would have found it motivated to utilize the use of graphical representation of a source patent and claim as well (RIVETTE's para 1368-1368; fig. 164 and 185), into the system of TRAN for the purpose of having

Art Unit: 2162

tools including modules to track and process of Patent or Intellectual property related transaction such as license agreements, therefore, enabling user to use automated tools that automatically process patent related information for making corporate business decision (RIVETTE's para 0003-0008 and 0020-0021).

With respect to claim 11, TRAN teaches a method for drafting a patent application (fig. 1, a system for user(s) such as IP specialist or attorney in drafting or writing patent applications or patent claims as well as technical information as legal matters for a patent application: para 0006, 0010 and 0132-0133) comprising the steps of:

entering information relating to components of a patentable invention by at least one user; automatically generating a visual diagram of the components of the invention in a hierarchical relational diagram, including at least one key component and at least one subcomponent associated with the at least one key component, wherein the visual diagram is a diagrammatic representation of an invention, wherein the diagrammatic representation includes a hierarchical component categorization of the technical components of the invention based upon the user inputted information, and automatically generating a document for filing as a patent application, including specification and claims, based upon the user inputted information and additional text-based detailed information that is organized consistent with the diagram; wherein the hierarchical component categorization includes at least one key component and at least one subcomponent related thereto; and the at least one user viewing the diagram and text-based information in a tangible medium, wherein the diagrammatic representation

Art Unit: 2162

of the components and sub-components together provides an indication of what may be claimed in a patent application (inputting from one of client computers: fig. 1, items 104 and 106, para 0035; using graphical user interface and software for assisting the user in generating a patent application: para 0042-0043 and fig. 2A and 2C; see fig. 3B a claim tree, para 0068; automatically generating a patent application: fig. 2's para 0042; technical component such as background, description, drawings and claims: abstract, figs. 2C, 3A and 4-5, para 0008, 0016, 0046 and 0101-0103; independent claims and dependent claims: in fig. 3B claim tree and para 0053-0054; and the claim tree is displayed on the desktop screen, output device: para 0127 and fig. 3B; and computer-readable medium such as a disk: para 0049); and modifying any previously inputted components within the diagram; and the system automatically updating the diagram and relational information to those modified components (the text of a patent application is enabling to update or edit: para 0044 and claim tree is also able to move or to modify (drag/drop claims): para 0068).

TRAN teaches methods and system for processing intellectual property assets; drafting or writing patent applications; creating and displaying a claim tree under graphical interface, diagramming elements of the claim in a graphical representation: a flowchart of steps of claim drafting with user input and including the system diagramming the elements of a claim. The window displays icons and drop-down menus. By clicking on items in the background windows, a user can navigate the claim tree. The user such as IP specialist or attorney in drafting or writing patent applications or patent claims as well as technical information as legal matters for a patent

Art Unit: 2162

application, generating an patent application including some technical components such background, invention summary, drawings, description, abstract and claims and displaying the claim tree to user. Also, TRAN teaches displaying a flowchart of steps of claim drafting with user input (fig. 3A, para 0052) and including at the step 312, the system diagramming the elements of a claim (para 0068-0079) and fig. 3B illustrating the diagrammed claim, showing the hierarchy of elements (para 0080), analogous to the claimed components and subcomponents, wherein the highest level node in fig. 3B is the claimed at least one key component. TRAN does not explicitly teach wherein the diagrammatic representation comprises graphical component structure and textual component content wherein the textual component is positioned within the graphical component structure for each component associated with each component such that for each component, the graphical component Structure includes the full text of the textual component content wherein the textual component and the diagram components are automatically directly linked by being visually integrated with one another within the diagrammatic representation as claimed.

However, RIVETTE teaches image file and text file are presentations of patent (para 0429); the patent is represented by icon (para 0980 and fig. 73 and 164); claim tree (fig. 185; para 1368-1369); hyperlinking using a linked list of nodes for switching to view the desired component (para 1231-1233; also para 1236-1240). This is the same as the graphical component of a patent including drawings, claims, abstract, summary and detail specification and is illustrated and displayed under a hierarchical tree with



Art Unit: 2162

graphical component structure (see figs 164 and 185) and classification or categorization the patent/document (para 0727, 1434, and 2080).

Therefore, based on TRAN in view of RIVETTE, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of TRAN with the teachings of RIVETTE. One having ordinary skill in the art would have found it motivated to utilize the use of graphical representation of a source patent and claim as well (RIVETTE's para 1368-1368; fig. 164 and 185), into the system of TRAN for the purpose of having tools including modules to track and process of Patent or Intellectual property related transaction such as license agreements, therefore, enabling user to use automated tools that automatically process patent related information for making corporate business decision (RIVETTE's para 0003-0008 and 0020-0021). Combination of TRAN and RIVETTE do not teach wherein the graphical component structure and textual component content being integrally visually generated and link in a single interactive diagram as claimed.

However, BLAIR teaches a navigation tree and text document with links shown as in the fig. 2, RFQ that is selected from the tree navigation structure. As shown in this example, this is a text document with PDF format that includes hyperlinks; the RFQ by showing a tree navigation arrangement on the left side of the screen, and corresponding details on the right side. As shown in this example, the navigation tree in the electronic RFQ basically operates as a Table of Contents (TOC) to the RFQ documents (para 0030-0032). All the structure or directory of document and the text-

Art Unit: 2162

based document are integrally in a same window with modifiable graphical hierarchical tree structure.

Therefore, based on TRAN in view of RIVETTE, and further in view of BLAIR, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of BLAIR to the system of TRAN and RIVETTE. One having ordinary skill in the art would have found it motivated to utilize the use of interactive diagram as disclosed (BLAIR's para 0030-0032), into the system of TRAN for the purpose of providing documents in PDF format for easing to extract, thereby, enabling to provide a single application or document can be used to view all documents (BLAIR's figs. 1 and 2, para 0002-0004, 0014-0016 and para 0030-0032).

With respect to claim 12, TRAN teaches further including the step of: at least one user entering diagram verbiage by drafting the text-based detailed description or verbiage of the specification section of the application for each component of the diagram wherein the text-based description and the diagram verbiage are automatically directly linked by being visually integrated with one another where the text associated with each component is included only within the diagram section for that component (a process performed by the software for assisting the user in generating a patent application: figs. 2's and 3B).

With respect to claim 13, TRAN teaches further including the step of: at least one user inputting additional components selected from the group consisting of key components, subcomponents, and sub-subcomponents (a patent application has background, summary, description, drawings and claims components or such as one

Art Unit: 2162

independent claim has one or more dependent claims as shown in the fig. 3B: claim tree: para 0068; also see para 0008 and 0016).

With respect to claim 14, TRAN teaches further including the steps of: modifying any previously inputted components within the diagram; and the system automatically updating the diagram and relational information to those modified components (the text of a patent application is enabling to update or edit: para 0044 and claim tree is also able to move or to modify (drag/drop claims): para 0068).

With respect to claim 15, TRAN teaches further including the step of: automatically generating a patent application based upon the inputted information and the hierarchical diagram, including specification and claims (such as one independent claim has one or more dependent claims as shown in the fig. 3B: claim tree: para 0068 or a patent application has background, summary, description, drawings and claims components: para 0008, 0016 and 0044-0045).

With respect to claim 16, TRAN teaches a system for mapping technology using at least one computing device (fig. 1, a system for user(s) such as IP specialist or attorney in drafting or writing patent applications or patent claims as well as technical information as legal matters for a patent application: para 0006, 0010 and 0132-0133), comprising:

at least one input device connected to the at least one computing device for inputting information from at least one user (inputting from one of client computers: fig. 1, items 104 and 106, para 0035);

at least one processing means for automatically generating a diagrammatic representation of a technology including at least one key component and at least one subcomponent associated with the at least one key component (using graphical user interface and software for assisting the user in generating a patent application: para 0042-0043 and fig. 2A and 2C), wherein the diagrammatic representation includes a hierarchical component categorization of the technical components of the technology based upon the information inputted by the at least one user (fig. 3B a claim tree, para 0068; automatically generating a patent application: fig. 2's para 0042; technical component such as background, description, drawings and claims: abstract, figs. 2C, 3A and 4-5, para 0008, 0016, 0044-0046 and 0101-0103; and independent claims and dependent claims: in fig. 3B claim tree and para 0053-0054); and

at least one output device connected to the at least one computing device for outputting the automatically generated diagrammatic representation of a technology (the claim tree is displayed on the desktop screen, output device: para 0127 and fig. 3B) and wherein the diagram is modifiable by the at least one user and the diagram hierarchical component categorization and related text-based detailed information is automatically updated based upon the user modifications (the text of a patent application is enabling to update or edit: para 0044 and claim tree is also able to move or to modify (drag/drop claims): para 0068).

TRAN teaches methods and system for processing intellectual property assets; drafting or writing patent applications; creating and displaying a claim tree under graphical interface, diagramming elements of the claim in a graphical representation: a

Art Unit: 2162

flowchart of steps of claim drafting with user input and including the system diagramming the elements of a claim. The window displays icons and drop-down menus. By clicking on items in the background windows, a user can navigate the claim tree. The user such as IP specialist or attorney in drafting or writing patent applications or patent claims as well as technical information as legal matters for a patent application, generating an patent application including some technical components such background, invention summary, drawings, description, abstract and claims and displaying the claim tree to user. Also, TRAN teaches displaying a flowchart of steps of claim drafting with user input (fig. 3A, para 0052) and including at the step 312, the system diagramming the elements of a claim (para 0068-0079) and fig. 3B illustrating the diagrammed claim, showing the hierarchy of elements (para 0080), analogous to the claimed components and subcomponents, wherein the highest level node in fig. 3B is the claimed at least one key component. TRAN does not explicitly teach wherein the diagrammatic representation comprises graphical component structure and textual component content associated with each component such that for each component, the graphical component Structure for each component includes the full text of the textual component content for that component only as claimed.

However, RIVETTE teaches image file and text file are presentations of patent (para 0429); the patent is represented by icon (para 0980 and fig. 73 and 164); claim tree (fig. 185; para 1368-1369); hyperlinking using a linked list of nodes for switching to view the desired component (para 1231-1233; also para 1236-1240). This is the same as the graphical component of a patent including drawings, claims, abstract, summary

Art Unit: 2162

and detail specification and is illustrated and displayed under a hierarchical tree with graphical component structure (see figs 164 and 185); and mapping patent and document an classification or categorization the patent/document: para 0727, 1434, and 2080 and mapping: abstract, para 0026, 0067 and 0076 and see figs. 59-60 and 84).

Therefore, based on TRAN in view of RIVETTE, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of TRAN with the teachings of RIVETTE. One having ordinary skill in the art would have found it motivated to utilize the use of graphical representation of a source patent and claim as well (RIVETTE's para 1368-1368; fig. 164 and 185), into the system of TRAN for the purpose of having tools including modules to track and process of Patent or Intellectual property related transaction such as license agreements, therefore, enabling user to use automated tools that automatically process patent related information for making corporate business decision (RIVETTE's para 0003-0008 and 0020-0021). Combination of TRAN and RIVETTE do not teach wherein the graphical component structure and textual component content being integrally visually generated and link in a single interactive diagram as claimed.

However, BLAIR teaches a navigation tree and text document with links shown as in the fig. 2, RFQ that is selected from the tree navigation structure. As shown in this example, this is a text document with PDF format that includes hyperlinks; the RFQ by showing a tree navigation arrangement on the left side of the screen, and corresponding details on the right side. As shown in this example, the navigation tree in the electronic RFQ basically operates as a Table of Contents (TOC) to the RFQ

Art Unit: 2162

documents (para 0030-0032). All the structure or directory of document and the text-based document are integrally in a same window with modifiable graphical hierarchical tree structure.

Therefore, based on TRAN in view of RIVETTE, and further in view of BLAIR, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of BLAIR to the system of TRAN and RIVETTE. One having ordinary skill in the art would have found it motivated to utilize the use of interactive diagram as disclosed (BLAIR's para 0030-0032), into the system of TRAN for the purpose of providing documents in PDF format for easing to extract, thereby, enabling to provide a single application or document can be used to view all documents (BLAIR's figs. 1-2, para 0002-0004, 0014-0016 and para 0030-0032).

With respect to claim 17, TRAN teaches a method for mapping technology (fig. 1, a system for user(s) such as IP specialist or attorney in drafting or writing patent applications or patent claims as well as technical information as legal matters for a patent application: para 0006, 0010 and 0132-0133) comprising the steps of:

entering information relating to components of a technology by at least one user; automatically generating a visual diagram of the components of the technology in a hierarchical relational diagram, including at least one key component and at least one subcomponent associated with the at least one key component wherein the visual diagram is a diagrammatic representation of a technology, wherein the diagrammatic representation includes a hierarchical component categorization of the technical components of the technology based upon the user inputted reformation, wherein the

Art Unit: 2162

hierarchical component categorization includes at least one key component and at least one subcomponent related thereto, and the at least one user viewing the diagram and text-based information in a tangle medium (inputting from one of client computers: fig. 1, items 104 and 106, para 0035; using graphical user interface and software for assisting the user in generating a patent application: para 0042-0043 and fig. 2A and 2C; see fig. 3B a claim tree, para 0068; automatically generating a patent application: fig. 2's para 0042; technical component such as background, description, drawings and claims: abstract, figs. 2C, 3A and 4-5, para 0008, 0016, 0046 and 0101-0103; independent claims and dependent claims: in fig. 3B claim tree and para 0053-0054; and the claim tree is displayed on the desktop screen, output device: para 0127 and fig. 3B; and computer-readable medium such as a disk: para 0049); and modifying any previously inputted components within the diagram; and the system automatically updating the diagram and relational information to those modified components (the text of a patent application is enabling to update or edit: para 0044 and claim tree is also able to move or to modify (drag/drop claims): para 0068).

TRAN teaches methods and system for processing intellectual property assets; drafting or writing patent applications; creating and displaying a claim tree under graphical interface, diagramming elements of the claim in a graphical representation: a flowchart of steps of claim drafting with user input and including the system diagramming the elements of a claim. The window displays icons and drop-down menus. By clicking on items in the background windows, a user can navigate the claim tree. The user such as IP specialist or attorney in drafting or writing patent applications



Art Unit: 2162

or patent claims as well as technical information as legal matters for a patent application, generating an patent application including some technical components such background, invention summary, drawings, description, abstract and claims and displaying the claim tree to user. Also, TRAN teaches displaying a flowchart of steps of claim drafting with user input (fig. 3A, para 0052) and including at the step 312, the system diagramming the elements of a claim (para 0068-0079) and fig. 3B illustrating the diagrammed claim, showing the hierarchy of elements (para 0080), analogous to the claimed components and subcomponents, wherein the highest level node in fig. 3B is the claimed at least one key component. TRAN does not explicitly teach wherein the diagrammatic representation comprises graphical component structure and textual component content associated with each component such that for each component, the graphical component structure for each component includes the full text of the textual component content directly related only to that specific component, and outputting a viewable diagram of that categorization wherein each of the components and its corresponding text-based information and its corresponding diagram components are automatically directly linked by being visually integrated with one another within the graphical component structure as claimed.

However, RIVETTE teaches image file and text file are presentations of patent (para 0429); the patent is represented by icon (para 0980 and fig. 73 and 164); claim tree (fig. 185; para 1368-1369); hyperlinking using a linked list of nodes for switching to view the desired component (para 1231-1233; also para 1236-1240). This is the same as the graphical component of a patent including drawings, claims, abstract, summary

Art Unit: 2162

and detail specification and is illustrated and displayed under a hierarchical tree with graphical component structure (see figs 164 and 185); and mapping patent and document an classification or categorization the patent/document: para 0727, 1434, and 2080 and mapping: abstract, para 0026, 0067 and 0076 and see figs. 59-60 and 84).

Therefore, based on TRAN in view of RIVETTE, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of TRAN with the teachings of RIVETTE. One having ordinary skill in the art would have found it motivated to utilize the use of graphical representation of a source patent and claim as well (RIVETTE's para 1368-1368; fig. 164 and 185), into the system of TRAN for the purpose of having tools including modules to track and process of Patent or Intellectual property related transaction such as license agreements, therefore, enabling user to use automated tools that automatically process patent related information for making corporate business decision (RIVETTE's para 0003-0008 and 0020-0021). Combination of TRAN and RIVETTE do not teach wherein the graphical component structure and textual component content being integrally visually generated and link in a single interactive diagram as claimed.

However, BLAIR teaches a navigation tree and text document with links shown as in the fig. 2, RFQ that is selected from the tree navigation structure. As shown in this example, this is a text document with PDF format that includes hyperlinks; the RFQ by showing a tree navigation arrangement on the left side of the screen, and corresponding details on the right side. As shown in this example, the navigation tree in the electronic RFQ basically operates as a Table of Contents (TOC) to the RFQ

Art Unit: 2162

documents (para 0030-0032). All the structure or directory of document and the text-based document are integrally in a same window with modifiable graphical hierarchical tree structure.

Therefore, based on TRAN in view of RIVETTE, and further in view of BLAIR, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of BLAIR to the system of TRAN and RIVETTE. One having ordinary skill in the art would have found it motivated to utilize the use of interactive diagram as disclosed (BLAIR's para 0030-0032), into the system of TRAN for the purpose of providing documents in PDF format for easing to extract, thereby, enabling to provide a single application or document can be used to view all documents (BLAIR's figs. 1 and 2, para 0002-0004, 0014-0016 and 0030-0032).

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 2162

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Contact Information***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANH LY whose telephone number is (571) 272-4039 or via E-Mail: [ANH.LY@USPTO.GOV](mailto:ANH.LY@USPTO.GOV) (Written Authorization being given by Applicant (MPEP 502.03 [R-2])) or fax to (571) 273-4039 (unofficial fax number directly to Examiner's office). The examiner can normally be reached on TUESDAY – THURSDAY from 8:30 AM – 3:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **John Breene** (571) 272-4107.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any response to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or faxed to:

**Central Fax Center: (571) 273-8300.**

Anh Ly /AL/  
Examiner GAU: 2162  
MAY 24<sup>th</sup>, 2010

/John Breene/  
Supervisory Patent Examiner, Art Unit 2162